

REMARKS

The present response requests reconsideration of the rejected claims.

CLAIM OBJECTIONS

The objection to claims 2-15 is not understood. Further clarification is requested if the objection is continued.

CLAIM REJECTIONS UNDER 112

Claim 1 is rejected under 35 U.S.C. 112, second paragraph, for the recitation of "coating composition". This rejection is traversed.

It is respectfully submitted that "coating composition" is a term of art which is very well known to and understood by the skilled artisan. Numerous patents and claims include this term and a listing of some of these can be provided if necessary. However, the Komasa and Tomono references cited by the Examiner each refer to a "coating composition", and, thus, it should not be necessary to provide any further listing. Furthermore, powder coating compositions are well known in the art as well. This is amply demonstrated by Kirk-Othmer's *Encyclopedia of Chemical Technology*. Enclosed is a courtesy copy of volume 19, pages 1-27, thereof, published by John Wiley & Sons in 1982.

CLAIM REJECTIONS UNDER 102 and 103

Boyer Rejections

Claims 1, 2, 4-6, 8, 10, 12, 13 and 15 are rejected under 35 U.S.C. 102(b) as allegedly being anticipated by or, in the alternative, under 35 U.S.C. 103(a) as allegedly being obvious over Boyer. These rejections are traversed.

Anticipation requires that the reference disclose each and every element of the claimed invention. MPEP 2131. Boyer does not anticipate the claimed invention at least because it does not disclose a powder coating composition, as claimed. Instead, Boyer relates to solvent borne coating compositions. See, for instance, column 1, lines 51-55, the Examples, and claim 12.

"To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art." MPEP 2143.03 citing *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974) (emphasis in original). Such suggestion is not present where the reference teaches away from the claimed invention. MPEP 2141.02

The claimed invention is an "[e]lectrically conductive powder coating composition" (emphasis added), according to independent claim 1 from which all other pending claims depend. Boyer explicitly states that "the paint must remain non-conductive." Column 2, line 19. Boyer, thus, teaches away from conductive coating compositions, as claimed, and cannot make obvious the claimed invention.

Komassa/Tomono Rejections

Claims 1-15 are rejected under 35 U.S.C. 102(b) as allegedly being anticipated by or, in the alternative, under 35 U.S.C. 103(a) as allegedly being obvious over Komassa or Tomono. These rejections are traversed.

Neither of these references disclose a powder coating composition, as claimed. They both relate to solvent borne coating compositions. See the references themselves and the present specification's discussion thereof, page 2, lines 23-27, and page 2, lines 17-21. Additionally, Komasa does not even disclose conductive coatings. Accordingly, neither of these references can anticipate or make obvious the claimed invention.

Withdrawal of the objection and rejections is requested. The Examiner is encouraged to contact the undersigned if there are any open issues in this case.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Lainie E. Parker', is written over a horizontal line.

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Encl: Kirk-Othmer *Encyclopedia of Chemical Technology*, Volume 19, 1982, John Wiley & Sons, pages 1-27.